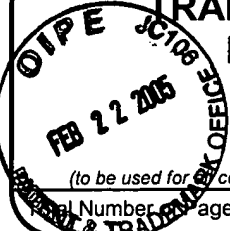

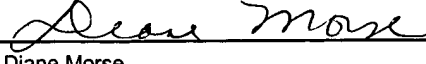


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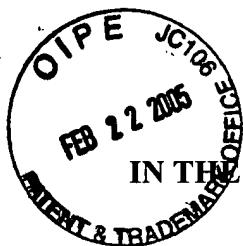
 <p>TRANSMITTAL FORM</p> <p>(to be used for correspondence after initial filing)</p>	Application Number	08/924,785
	Filing Date	9/5/97
	First Named Inventor	Richard W. Pratt
	Art Unit	2142
	Examiner Name	Prieto, Beatriz
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ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Reply Brief; return postcard
Remarks 		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm	Thelen Reid & Priest LLP		
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Date	2-14-2005	Reg. No.	31,562

CERTIFICATE OF TRANSMISSION/MAILING			
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Signature			
Typed or printed name	Diane Morse	Date	2-15-05

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Richard W. Pratt
SERIAL NO.: 08/924,785
FILING DATE: September 5, 1997
TITLE: SYSTEM AND METHOD FOR REMOTE DEVICE MANAGEMENT
EXAMINER: Prieto, Beatriz
ART UNIT: 2142

REPLY BRIEF

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Dear Sir:

This paper is in response to the Examiner's Answer mailed on December 16, 2004.

Please consider the following.

REMARKS

Claims 44, 62-64, and 67-74 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Madany* (US 5,922,050) in view of *Beard* (US 6,067,577) in further view of *Nakagawa et al.* (US 5,832,911). This rejection is respectfully traversed.

Generally, the Grounds for Rejection in the Examiner's Answer are substantially identical to that of the Office Action dated April 21, 2004. The Response to Arguments section of the Examiner's Answer contains eight numbered paragraphs designated 3-10. These will be considered in turn below.

As noted succinctly in the Appeal Brief, the Office Action and now the Examiner's Answer overextend the primary reference of *Madany* and use this misinterpretation as the basis for combining with the other two references. Properly understood, the references can not be combined. Further, the Office Action and the Examiner's Answer fail to provide proper motivation for the proposed combination. Generic recitations of alleged elements or limitations by *Beard* and *Nakagawa* do not provide sufficient basis for combining these elements or limitations with *Madany*.

Never addressed in the Examiner's Answer is the fact that according to M.P.E.P. § 2141.02, "[I]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention *as a whole* would have been obvious." The Office Action and the Examiner's Answer employ loose citations and logic to result in a rejection that is in violation of this principle. Two individual motivations for prior art differences are provided with no single

motivation for the invention as a whole as required. Even if the individual motivations are found to be acceptable, the two individual motivations provided do not motivate the claimed invention as a whole. Simply justifying each additional reference is inadequate. This alone is independent grounds for withdrawing the rejection. There must be a showing that the prior art had a specific understanding and motivation to make the claimed combination and not just each individual modification. The Appellant respectfully asserts that such a showing has not even been attempted let alone been made. The Appellant went even further in the Appeal Brief to contend that such a showing can not be made for the invention as a whole and that the individual motivations are also inadequate. If either of the individual motivations are found to be insufficient, then this provides further independent grounds for withdrawing the rejection.

As noted in the Appeal Brief, the core of the rejection is the system taught by *Madany*. The context and boundaries of the teachings of *Madany* are important to consider when determining what one of ordinary skill in the art would garner from the reference. One of ordinary skill would read the entire reference and not just judiciously selected excerpts. The Appeal Brief goes to great length to demonstrate that *Madany* emphasizes the use of a low-cost device. This reality is not effectively refuted in the Examiner's Answer. Some of the individual statements in the Appeal Brief are selected for rebuttal, but the overall contention remains intact even if the Examiner's responses are found to be individually persuasive. Open speculation as to how the system of *Madany* would operate if the limitation of low-cost were removed is tantamount to hind sight reconstruction of the claims. *Madany* does not present an unlimited cost embodiment. If it is not taught by *Madany*, then any adaptations or assumptions must be properly cited and motivated to avoid over-extending the reference.

It should be noted that the Examiner's Answer fails to directly address the arguments presented specifically with respect to *Beard* and *Nakagawa* on pages 14 and 15 of the Appeal Brief. To the extent that any of the numbered responses of the Examiner's Answer might apply to these arguments indirectly will be addressed below. The arguments contend that the references can not be combined and that proper motivation has not been provided. These arguments provide further independent grounds for withdrawal of the rejection.

Turning first to paragraph 3 of the Response to Arguments section of the Examiner's Answer, the Examiner's Answer states that "...no explicit or implicit recitation or evidence of [the contention that *Madany* achieves low-cost by reducing to the bare minimum] is provided in the citation from column 1, line 11 through column 2, line 7." First, it was not previously stated that this passage was support for the contention. In fact, immediately following the contention is a supporting quote from column 2, lines 10-23 of *Madany* that concludes with the statement that "[t]he invention *maintains* the low cost of the device while permitting control of the device by a program incapable of execution by the device itself." The implication being that without vigilance it might be easy to allow needless features to make their way into the design and spoil the vital low cost result. Second, there are at least three citations from column 1, line 11 through column 2, line 7 that do provide support for the contention. On column 1, lines 42-47, *Madany* explicitly chooses saving costs over adding hardware when he states that "...the addition of hardware sufficient to execute such [high level] programs may increase the cost of the device to a point where the device is not competitive." *Madany* reiterates this on column 1, line 66, through column 2, line 3 where he states that "...as with other high level languages, the minimum computing resources and memory requirements for a device capable of executing a JAVA program would increase the price of a low-cost device beyond commercial feasibility."

Madany concludes on column 2, lines 4-7 that "...a mechanism is necessary to permit a low-cost device to be controlled by an application program requiring a significant amount of computing hardware, yet *maintaining* a relatively low cost for the device." Given the low cost context of *Madany*, in order for one to propose additions to the disclosed device of *Madany* while maintaining its low cost nature, one must either remove the low cost requirement or prove that the addition would not violate the requirement. The rejection implicitly assumes the former without proper justification and never even attempts the latter. In conclusion, the contention in the Appeal Brief is abundantly supported by *Madany* and no counter evidence or analysis is submitted.

Turning now to paragraph 4, the Examiner's Answer states that the underlying assumption made in the Appeal Brief that "...the consumer has or is willing to buy at least one high cost device to realize the system [of *Madany*]" is not supported. Frankly, the statement is hardly extreme and should be substantially self evident. The system of *Madany* requires at least one high cost device such as a computer 10 or 12 of FIG 1. Without it the system does not work as disclosed. Moreover, even if this assumption is not entirely supported, the statement is not the crux of the argument that *Madany* should be limited to the context of low cost devices. The fundamental contention of the Appeal Brief stands substantially unrefuted.

Turning now to paragraph 5, the Examiner's Answer attempts to refute the ultimate conclusion on page 10 of the Appeal Brief that "...one of ordinary skill in the art would discount the recitation of a possible computer-type device [on column 3, line 45] by *Madany* as unsupported or erroneous." The Examiner's Answer notes that "...the reference reads what it reads." The Appellant respectfully adjusts this to say that the reference reads *only* what it reads,

nothing more, and that what it reads is not undeniable fact. For example, what a reference reads may not be supported or supportable like professing to have invented a perpetual motion machine. Also, what a reference reads may be internally or externally contradictory like disclosing a flexible member that is rigid without more. To an extent, these are among the points of the disputed conclusion. The pertinent disclosure by *Madany* is one word long. There is nothing more. Anything beyond that is an implicit and unsupported assumption that is made by the rejection. *Madany* does not give examples of a computer-type device. He does not equate a computer-type device to the computers 10 and 12 of FIG 1. Even more example omissions by *Madany* are provided in the Appeal Brief on page 10. As noted in the Appeal Brief, the discussion of *Madany* contains a computer/device dichotomy. The Examiner's Answer ignores this and provides citations from both sides of the dichotomy in an apparent attempt to blur the line established by *Madany*. Further, the Examiner's Answer attempts to dispute the contention that a computer-type device would be known to one of ordinary skill in the art as a general purpose device by citing the example by *Madany* of a "personal computer" on column 3, line 37. Further still, the Examiner's Answer attempts to rely on quotes containing ambiguous words such as "anything", "and the like", "processor", and "any type" from *Madany* as implicit bases for the rejection. First, the personal computer example is given by *Madany* only with respect to the computers of FIG. 1 and not with respect to the computer-type device of FIG. 2. Second, this example is contradictory to the attempted response as a personal computer is by its character a general purpose device. Third, efforts to bolster the rejection based on a few ambiguous words is an illegitimate attempt to overextend the word computer on column 3, line 45. The response attempts to limit implications that might be made from the word computer to only those that benefit the rejection without addressing those that might argue against the rejection. For example, the teachings by *Nakagawa* do not apply to non-computer-type devices. This is not

disputed and poses a serious obstacle to combining the references. Without more, a single word in a reference is at least, if not more, likely to be ignored than to be the basis for importing all of the world's knowledge to date on the subject. Arguments in favor of the former position have been presented here and in the Appeal Brief. Arguments in favor of the latter are absent from the record and can not simply be implied. The record must include more than conclusory statements of generalized advantages and convenient assumptions about what skilled artisans would know, learn, or be motivated to do. Moreover, it is important to note that no attempt has been made to counter the argument on page 10/11 of the Appeal Brief, that even if one of ordinary skill does not fully discount the computer-type device disclosure of *Madany*, that such a computer-type device should be limited to FIG. 2 of *Madany*. The rejection incorrectly goes beyond the bounds of FIG. 2 in its assumptions bringing in whatever it takes to amass support for the rejection. This issue is addressed at some length in the Appeal Brief on pages 11-13. In conclusion, the contention of the Appeal Brief should be found to stand.

Turning now to paragraph 6, the Examiner's Answer states that certain portions of page 10 of the Appeal Brief are not recited in the rejected claims. However, this is not the thrust of page 10. The discussion is with respect to explaining the teachings of *Madany*. Recall that the context and boundaries of the teachings of *Madany* are important to consider when determining what one of ordinary skill in the art would garner from the reference. It was never contended that the aspects pointed out are distinguishing features of the claimed invention. The paragraph is therefore non-responsive.

Turning now to paragraph 7, the Examiner's Answer states that certain portions of pages 11 and 12 of the Appeal Brief are not recited in the rejected claims. However, this is not the

thrust of pages 11 and 12 either. The discussion continues to be with respect to explaining what one of ordinary skill would garner from the teachings of *Madany*. It was never contended that the aspects pointed out are distinguishing features of the claimed invention. The paragraph is therefore non-responsive.

Turning now to paragraph 8, the Examiner's Answer attempts to refute two different and unrelated contentions with one response. The first contention is that the limited disclosure by *Madany* of what he means by the term device processor 22 "...excludes a whole range of possible hardware that might be erroneously equated with the processor 22 based on FIG. 2 alone." This again is with respect to explaining what one of ordinary skill would garner from the teachings of *Madany*. Among the points being that not all processors are created equal and it would be inappropriate for one to imply that the use of the term alone opened up all possibilities. To do so would be to improperly ignore the context of *Madany*. The second contention is that "[t]here is no discussion of updating the applet by *Madany*." Among the points being that the claims includes "new" and "old" downloadable units, but *Madany* does not disclose more than one applet per device. It is therefore impossible for *Madany* to disclose updating to a new one from an old one. There is only one applet. The response to both of these contentions is that *Nakagawa* discloses file substitution in theory. Among other issues, the fact that *Nakagawa* is from another context is ignored. File substitution appears to have nothing to do with the first contention about processors. As for the second contention about updating, whether or not *Nakagawa* discloses file substitution is irrelevant. If there is only one applet disclosed by *Madany*, then there is nothing to substitute. The rejection fails to directly argue for the existence of more than one applet. Duplicate citations are not enough. The existence of more than one applet can not be merely implied. This is another implicit and unsupported assumption of the

rejection. The possible existence of more than one applet ties in indirectly with the motivation to update below with respect to paragraph 9. In conclusion, the rejection is incomplete and the paragraph is non-responsive.

Turning now to paragraph 9, the Examiner's Answer attempts to refute the contention that "...there is not motivation to update the applet in the *Madany* reference" by providing one alleged example. The example is that over time processors will change and therefore the applet will have to change to maintain compatibility. This is the first time that such motivation has been provided in this regard. Whether or not this is proper is rendered moot by the fact that the example is contradicted by the very passage that is meant to support it. As cited by the Examiner's Answer, *Madany* discloses on column 4, lines 36-42 that "[b]y using an architecture-independent language such as JAVA, the applet may be executed on any type of computer and any type of processor. Therefore, a single device may be manufactured without regard to the type of computer or processor to which it is connected. Additionally, the device may continue to be supported by new processors developed in the future." Thus the example fails to provide motivation to update the applet. No other examples have been provided. The contention thus stands unrefuted. Additional pertinent issues relating to updating with respect to *Nakagawa* can be found on pages 14 and 15 of the Appeal Brief.

Turning finally to paragraph 10, the Examiner's Answer attempts to refute the contention that "...the *Beard* reference fails to teach retrieving embedded software." However, this contention was never made in the Appeal Brief. This is not to say that such a contention might not be possible, but it has not been made so far. Further, the paragraph does not address any of

the contentions that have been made with respect to *Beard* on page 14 of the Appeal Brief. The paragraph is therefore non-responsive.

Request for Allowance

In view of the foregoing, reconsideration and an early allowance of this application are earnestly solicited.

If any matters remain which could be resolved in a telephone interview between the Examiner and the undersigned, the Examiner is invited to call the undersigned to expedite resolution of any such matters. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
THELEN, REID, & PRIEST LLP



David B. Ritchie
Reg. No. 31,562

Dated: February 14, 2005

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